

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles Eldering.

Conf. No.: 1665 : Group Art Unit: 2423
Appln. No.: 10/759,620 : Examiner: CHIN, Ricky
Filing Date: 16 JANUARY 2004 : Attorney Docket No.: T708-14
Title: Advertisement Management System for Digital Video Streams

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
- ☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: _____

9/21/11

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STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 1, 3, 5 – 8, 10 -18, 22, 23 and 25 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated June 21, 2011 ("June Final Office Action"), the Non-Final Office Action dated September 28, 2010 ("September Office Action"), the Final Office Action dated March 31, 2010 ("March Final Office Action"), and the Non-Final Office Action dated October 15, 2009 ("October Office Action"), and other previous Office Actions in the application. Discussion of the prior art references and the pending claims may be found in Applicants' Request for Reconsideration, filed March 24, 2011 ("March Request for Reconsideration"), Applicants' Amendment After Final Rejection, filed September 14, 2010 ("September Amendment After Final"), Applicants' Amendment, filed January 15, 2010 ("January Amendment"), and Applicants' Amendment Accompanying RCE, filed July 29, 2009 ("July Amendment Accompanying RCE"), and other previous Amendments/Responses, all of which are incorporated herein by reference.

No Prima Facie Case of Obviousness

Even though the Examiner has not established a *prima facie* case of obviousness, the Examiner has maintained the rejection of claims 1, 3, 5 – 8, 10 – 18, 22, 23 and 25 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,661,516 to Carles ("Carles"), in view of U.S. Patent No. 5,652,615 to Bryant ("Bryant"), U.S. Patent Application Publication No. 2006/0041921 to Hane ("Hane"), U.S. Patent No. 6,487,721 to Safadi ("Safadi"), and U.S. Patent No. 5,754,787 to Dedrick ("Dedrick"). Applicants maintain that combining Carles with Bryant, Hane, Safadi and Dedrick would render Carles inoperable; and, such combination – even is possible – does not teach or suggest all aspects of the claims.

1. The combination of Carles, Bryant, Hane, Safadi and Dedrick is inoperable.

As discussed at length in the March Request for Reconsideration (see pages 11 – 12), the proposed combination of Carles, Bryant, Hane, Safadi and Dedrick would render Carles inoperable and/or change the principle of operation thereof. MPEP § 2143.01(V) states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is *no* suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" (emphasis added). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of

the references are *not sufficient* to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” (emphasis added).

Carles teaches inserting advertisements based on a previously created schedule. Bryant attempts to utilize all bandwidth in a programming stream and group advertisements to utilize such bandwidth in real time. Hane teaches an electronic exchange for avail sales that will “immediately determine” whether a particular advertisement should be inserted. (Hane, paragraph 68). If the methodology of Carles were attempted to be modified to insert advertisements in a manner to utilize all of the bandwidth in the stream (i.e., Bryant), Carles **could not possibly utilize** a predefined scheduled. If the methodology of Carles were attempted to be modified to “immediately determine” which advertisement is being used (i.e., Hane), it **could not possibly** have a predefined schedule. That is, Bryant and Hane would require alterations to Carles’ previously created, predefined schedule at every insertion opportunity, thereby defeating Carles’ stated purpose of an advertisement schedule in the first place. As such, the proposed combination is improper since any modification of Carles’ teachings by Bryant and/or Hane would effectively change the principle of operation of Carles.

The Examiner has explicitly failed to read the prior art references “as a whole” as required by MPEP § 2143.03(VI). Rather, the Examiner has admittedly only considered small portions of Bryant, Hane and Dedrick in asserting the proposed combination. First, the Examiner states that “the *aspect* of Bryant and Hane relied upon are *mere* teachings used to enhance ...” the teachings of Carles (June Final Office Action, page 6, emphasis added). The Examiner continues that “Bryant is *merely* relied upon for the teaching of determining an avail bandwidth ...” (Id.). The Examiner concludes that by only looking at these teachings of the references, “the modifications would in no way effect the operation and system of Carles.” (Id. at pages 6 – 7). In making this argument, the Examiner has overtly ignored the MPEP by “merely” reading certain “aspects” of the prior art, rather than considering them in their “entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” However, as explained above, reading the entire secondary references and applying the proposed modifications (including the portions which the Examiner chooses to ignore) would leave no doubt that the combination is impossible and/or leaves the primary reference inoperable.

The Examiner’s failure to read the references as a whole is particularly problematic since the Examiner applies a combination of five references in asserting that Applicants’ claims are obvious. The difficulty in determining what results from such a combination does not allow the Examiner to only consider small portions of the prior art while ignoring the rest.

2. The Examiner has Incorrectly Applied the Law

The Examiner incorrectly alleges that Applicants have shown non-obviousness by attacking the references individually, relying on *In re Keller*. (See June Final Office Action, page 2). Applicants note that the Examiner chose to rely on Dedrick alone as teaching the questioned claim element, as “the combination of Carles, Bryant, Hane, and Safadi ... does not explicitly teach,” this portion of the claim. (September Office Action, pages 8 – 9). As such, it is established that Dedrick does not teach what the Examiner contends, Applicants have effectively shown that the Examiner has not demonstrated that the prior art teaches all elements of the claims. In doing so, Applicants have not attacked the references individually, but have instead attacked the Examiner’s faulty argument and reading of those reference(s). Furthermore, the Examiner has improperly relied on *In re Keller* to suggest that proving that one reference of a multi-reference obviousness rejection lacks a particular teaching is improper. In *In re Keller* the appellants did **not** argue that all elements were not taught in the references.¹ Rather the issue was whether the elements themselves could be combined. The Court accurately stated that when all elements are taught by a combination of references, “one cannot show non-obviousness by attacking references individually.” (*In re Keller* at 426) As such, it is not improper to show, as Applicants have shown, that a single reference does not teach the element which the Examiner relies on in that single reference when the Examiner agrees that the combination of all other references does not teach said element. In addition, Applicants have previously explained that the combination of references does not teach or suggest the questioned claim element, and thus do not solely rely on Dedrick’s failings. (See, for example, March Request for Reconsideration pages 9 – 11).

3. The Examiner’s Apparent 35 U.S.C. §112 and New Prior Art Rejections are Improper

In the June Final Office Action, the Examiner appears to issue a new rejection under 35 U.S.C. §112² and/or a new prior art rejection.³ Applicants note that if either of these statements is intended to be

¹ In *In re Keller*, the invention was for a pace maker with a digital timer. The rejection was to Keller, Berkovits and Walsh. All elements except for the use of a digital timer was taught in Keller and Berkovits, with the timer taught by Walsh. (See *In re Keller* at 421 – 422). “Appellant does not argue that any features of the rejected claims other than the use of digital timing are not disclosed in Keller and Berkovits. Thus, the sole issue regarding the prior art rejections is essentially whether the references, taken collectively, would have suggested the use of digital timing in a cardiac pacer to those of ordinary skill in the art at the time the invention was made.” (*In re Keller* at 424). The Appellant focused that Walsh was not known to be used for the heart. (*In re Keller* at 424 – 425). The Court noted that since the digital timer of Walsh was to be used in combination with Keller and Berkovits, a showing that Walsh alone could not be used was insufficient to rebut obviousness as “one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references” (*In re Keller* at 426). However, there was no argument that all elements were not taught by the references.

² “...resulting in the minimum bandwidth requirement being satisfied could not be found anywhere in the applicants specification.” (June Final Office Action, page 4).

³ Noting that, “...if such limitations were present in applications specification, Hamilton, US 2009/0067510” could be relied upon. (June Final Office Action, pages 4-5).

rejections, the Examiner improperly issued a Final Office Action, as a Final Office Action is not appropriate “where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement.” (MPEP 706.07(a)).

4. **The Combination Does Not Teach All Elements of the Claims.**

The combination of Carles, Bryant, Hane, Safadi and Dedrick does not teach or suggest, “wherein the minimum bandwidth requirements identify a required amount of bandwidth available within the program stream for the advertisement to be inserted,” as recited in independent claim 1. The Examiner admits that Carles, Bryant, Hane and Safadi do not teach this feature of claim 1, relying on Dedrick. However, as discussed at least in the March Request for Reconsideration (see pages 8 – 9), in Dedrick an advertisement will be delivered regardless of the minimum bandwidth requirements; Dedrick merely teaches analyzing the available delivery links to identify the link that best matches those requirements. In contrast, in claim 1, an advertisement is selected for delivery only if the bandwidth requirements may be satisfied. There is no such teaching in Dedrick.

The combination of Carles, Bryant, Hane, Safadi and Dedrick also does not teach or suggest, “compressing, based at least in part on the avail bandwidth, the selected targeted advertisement such that the minimum bandwidth requirements are satisfied,” as recited in independent claim 1. The Examiner relies on Safadi for this teaching, contending that, “the commercial may be compressed as to enable rate adaptation such that the commercial content fits the bandwidth allocated for the program to which the commercial belongs.” June Final Office Action, page 117. However, as discussed at least in the March Request for Reconsideration (see pages 10 – 12), the Examiner has misread Safadi. Additionally, even if the Examiner’s interpretation of Safadi was correct, the “compressing” in Safadi results in matching the advertisement bandwidth to the bandwidth allocated for the *program* into which the advertisement will be inserted. In contrast, in claim 1, the advertisement is compressed such that the **minimum bandwidth requirements of the advertisement or advertiser are satisfied.**

The Examiner’s response initially appears to agree with Applicants that, “Safadi teaches that the commercial ... may be compressed such that the contents fits the bandwidth allocated for the *program*.” (June Final Office Action, page 4, emphasis added). Applicants note that claim 1 teaches “compressing, based at least in part on the *avail* bandwidth, the selected targeted advertisement such that the minimum bandwidth requirements [of the advertisement] are met.” Compressing an advertisement to a program’s bandwidth simply does not teach this. The Examiner’s failure to recognize that a program bandwidth is

not the same as an avail bandwidth is very instructive. Old technology, such as Safadi, works in a system where an avail bandwidth need not be considered, since a traditional television would not vary the avail bandwidth from the program bandwidth.⁴ In contrast, claim 1 begins and ends with an “avail bandwidth,” that is not related to the program bandwidth. The compression is based at least in part on this avail bandwidth. Since claim 1 is a method which specifically recites an avail bandwidth and a minimum bandwidth for an ad related to bidding, the difference between an avail bandwidth and a program bandwidth is not inconsequential. In fact, the technology recited in claim 1 would be of no use with a compression system focused on a program (i.e., Safadi) as opposed to an avail.

The core of the Examiner’s response suggests that the recitation of “such that the minimum bandwidth requirements are satisfied,” has no meaning at all. The Examiner argues that this feature is met as “any time the selected advertisement is compressed to fit the avail of the bandwidth and also matches the minimum bandwidth requirement ... the compression would satisfy the minimum bandwidth requirement.” (June Final Office Action, page 4). Applicants disagree that the claim language suggests a happenstantial relationship, as “compressing... the selected targeted advertisement such that the minimum bandwidth requirements are satisfied,” is an explicit action that the minimum bandwidth requirements be met, not a coincidence as suggested by the Examiner. Moreover, the point is moot as Safadi, the only reference relied upon by the Examiner, does not even have minimum bandwidth requirements to coincidentally meet. As such, even under the Examiner’s faulty reading, Safadi alone, or in combination with the other references, does not teach this element.

For all of the above reasons, the Examiner has failed to show any reference which, alone or in combination, teaches each and every element of independent claim 1. Furthermore, one skilled in the art would not have found it obvious to result in the subject matter of claim 1 based on the proposed combination. Independent claims 22 and 25 recite similar elements as claim 1, and, thus, the same arguments are applicable to claims 22 and 25. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein, as well as in previous responses, independent claims 1, 22 and 25, and all claims dependent thereon, are allowable over the combination of Carles, Bryant, Hane, Safadi and Dedrick. Applicants respectfully submit that the Examiner's rejections have been previously overcome, and the application, including claims 1, 3, 5 – 8, 10 -18, 22, 23 and 25, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.

⁴ Applicants note that Safadi includes “new commercial insertion capability [that] can be added to existing uplink and headend equipment in a backward compatible manner.” (Safadi, Abstract). It is consistent in this regard in speaking of traditional television.